

REMARKS

The Applicants would like to thank the Examiner for the quick and courteous non-final Office Action.

The claims remaining in the application are 20-29, 31-38 and 40-43. Independent claims 40, 42, and 43 are amended herein. No new matter has been added.

Rejection Under 35 U.S.C. §112, First Paragraph

The Examiner has rejected claims 40-43 under 35 U.S.C. §112, first paragraph, as based on a disclosure which is allegedly not enabling. The Examiner noted "the copolymer being in the form of a latex, critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure", citing *In re Mayhew*. The Examiner asserts that the Applicants' disclosure teaches that the polymer being a latex is essential (referring to paragraph 0027), thus, the lack of such teaching in the claim renders the disclosure non-enabling.

The Applicants hereby respectfully direct the Examiner's attention to the amendments to claims 40, 42 and 43 herein where the copolymer has been further defined as a "copolymer latex" as helpfully suggested by the Examiner himself. Support for the inclusion of the word "latex" in this context is found in paragraphs 0027-0028 and elsewhere and thus does not constitute an improper insertion of new matter. Applicants thus respectfully submit that the instant rejection is overcome and rendered moot. Reconsideration is respectfully requested.

Rejection under 35 U.S.C. §102(e) over Stowe, et al.

The Examiner rejected claims 20-29 and 31-38 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Pat. No. 6,703,351 to Stowe, et al.

The Examiner finds that the applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, the Examiner contends that it constitutes prior art under 35 U.S.C. §102(e). The Examiner notes that this rejection under 35 U.S.C. §102(e) might be overcome either by a showing under 37 CFR §1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this

application and is thus not the invention "by another", or by an appropriate showing under 37 CFR §1.131.

The Examiner contends that Stowe, et al. teaches the same method of the present invention utilizing the same latex containing fluid, and that the filing date of Stowe, et al. is prior to the claimed filing date of the present application, and it thus constitutes prior art.

The Applicants would respectfully traverse. The Applicants are further confused by this rejection.

The Applicants respectfully note that the subject CIP application properly claims the benefit of the parent application U.S. Patent Application 09/785,842 filed February 16, 2001, which issued as U.S. Pat. No. 6,703,351 to Stowe, et al. The Examiner's attention is respectfully directed to paragraph 0001 on page 1 of the subject application, and to the fully signed Combined Declaration and Power of Attorney submitted on December 12, 2003 in the subject application. Thus, Applicants respectfully submit, any claims in the subject application *have the same effective filing date* as Stowe, et al. to the extent that they are the same as those of Stowe, et al. and thus cannot be anticipated thereby. To the extent that the new claims in the subject case are obvious therefrom, a timely-filed terminal disclaimer is sufficient to overcome such obviousness-type double-patenting rejection. The Examiner herein made such an obviousness-type double-patenting rejection in the Action dated December 28, 2005, and a terminal disclaimer was timely-filed with the Amendment of March 27, 2006. Since this rejection was not repeated herein, Applicants understand that this rejection was overcome by the terminal disclaimer. Applicants further respectfully submit that the subject rejection of the instant claims over Stowe, et al. is improper and does not make sense in view of long-established CIP practice. In fact, it is not clear how any CIP application may be properly filed if rejections of the instant type are appropriate.

It is respectfully submitted that the subject rejection is improper, and that to the extent any conflict exists between the claims of the subject application and the parent application, such conflict has been overcome and obviated by the terminal disclaimer previously filed.

Reconsideration is respectfully requested.

Rejection under 35 U.S.C. §103(a) over GB 2131067

The Examiner rejected claims 20-24, 26-29, 31, 33, 36, and 37 under 35 U.S.C. §103(a) as allegedly unpatentable over GB 2131067 for reasons of obviousness. The Examiner finds that GB 2131067 teaches a method of drilling using a drilling fluid comprising a latex, water, surfactant, and bentonite which is an alumino-silicate, allegedly the same as the precipitating agent of the present invention. The Examiner asserts that the latexes would have particle sizes within the scope of claim 37. The Examiner admits that GB 2131067 differs from the present invention in not specifically exemplifying the use of a polyethylene latex. However, the Examiner contends that GB 2131067 teaches that hydrocarbon homopolymers or copolymers are preferred for use as the latex polymer and exemplifies ethylene/propylene copolymer. The Examiner alleges that it would be obvious to one of ordinary skill in the art to utilize polyethylene as the polymer of the latex of GB 2131067, given the teaching that hydrocarbon homopolymers or copolymers are preferred for use as the latex polymer, and the exemplification of ethylene/propylene copolymer. The Examiner contends that this teaching would lead one having ordinary skill in the art to utilize ethylene homopolymer in the latex of GB 2131067. Such would obviously inhibit borehole wall invasion as in the present invention the Examiner alleges.

Once more the Applicants would respectfully traverse. Applicants submit that it is the Examiner's burden to establish a case of *prima facie* obviousness of the pending claims; *In re Oeticker*, 977 F.2d 1443, 1445; 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). A *prima facie* case must be put forward by the Examiner; missing facts cannot be assumed, *Ex parte Wolters*, 214 U.S.P.Q. 735 (Bd. App. 1979).

GB 2131067 involves the addition of minor proportions of a polymer, which is insoluble in water, to oil-based or water-based drilling fluid to improve the rheological properties of the fluid and/or improve the fluid loss control of the fluid. The polymer is added in the form of an aqueous dispersion of the polymer (Abstract therein). Latexes mentioned by GB 2131067 in the paragraph bridging pages 1 and 2 are polybutadiene, polyisoprene, polyisobutylene, natural rubber latex, eth-

ylene/propylene copolymer and butadiene/styrene copolymer. Again, however, it is respectfully submitted that these latexes are not those now recited in present independent claims 20, 24 and 27.

The Examiner stated in the current rejection:

GB '067 differs from the present invention in not specifically exemplifying the use of a *polyethylene* latex. GB however teaches that hydrocarbon homopolymers or copolymers are preferred for use as the latex polymer and exemplifies *ethylene/propylene copolymer*. (Emphasis added.)

The Applicants respectfully disagree that these statements are not factually correct, and thus the conclusions that the Examiner draws from them are not factually correct. Not only is a polyethylene latex not exemplified in GB 2131067, a *polyethylene* latex is nowhere mentioned in GB 2131067, it is respectfully submitted. Further, an *ethylene/propylene copolymer* is also not exemplified, it is merely mentioned. The only polymers exemplified in the reference are as follows:

TABLE A

<u>Shorthand</u>	<u>Polymer or Copolymer</u>	<u>Location in GB 2131067</u>
PD1	Butadiene/styrene	Page 3, lines 39-40
PD2	Natural rubber latex	Page 4, line 34
PD3	Natural rubber latex	Page 4, line 40
PD4	Polyisobutylene	Page 4, line 47
PD5	Butadiene/styrene	Page 5, lines 1-2
PD6	Butadiene/styrene	Page 5, lines 9-10
PD7	Butadiene/styrene	Page 5, lines 29-30
PD8	Polyvinyl acetate homopolymer	Page 5, lines 31-32
PD9	2-ethyl hexyl acrylate/vinyl acetate	Page 5, lines 33-34

Thus, it is respectfully submitted that the rejection is based on incorrect facts. Missing facts cannot be assumed; *Ex parte Wolters, id.* It is respectfully submitted that for this reason alone, the instant rejection is not a *prima facie* rejection and must be withdrawn.

Further, Applicants respectfully submitted that it is *not* obvious to one having ordinary skill in the art that polyethylene latex would work in the inventors' method herein just because GB 2131067 merely *discloses* that ethylene/propylene copolymer would work. GB 2131067 does not teach, suggest, hint or disclose that any other copolymers with ethylene or propylene, or that polypropylene alone would be successful. It is respectfully submitted that there is nothing in GB 2131067 that suggests the desirability of modifying ethylene/propylene copolymer to polyethylene. "Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the *desirability* of the modification.' " *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989) (emphasis added). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the *desirability* of the modification." *In re Fritch*, 972 F.2d 1260, 1266; 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) (emphasis added). Applicants respectfully submit that the desirability of modifying the GB 2131067 disclosure to be what is claimed herein, a modification urged by the Examiner, is not in existence, and thus for this additional reason the instant rejection does not reach *prima facie* obviousness.

At most, it is respectfully submitted, the Examiner is only contending that it is "obvious to try" polyethylene, and "obvious to try" is not the proper standard of a 35 U.S.C. §103 rejection. "Obvious to try" has long been held not to constitute obviousness, *In re O'Farrell*, 853 F.2d 894, 903, 7 U.S.P.Q.2d 1673, 1680-81 (Fed. Cir. 1988). A general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out, *In re Deuel*, 51 F.3d 1552, 1559, 34 U.S.P.Q.2d 1210 (Fed. Cir. 1995).

"At best, in view of these disclosures, one skilled in the art might find it obvious to try various combinations of these known scale and corrosion prevention agents. However, this is not the standard of 35 U.S.C. §103. *In re Goodwin*, 576 F.2d 375, 377, 198 U.S.P.Q. 1, 3 (C.C.P.A. 1978); *In re Antonie*, 559 F.2d 618, 195 U.S.P.Q. 6 (C.C.P.A. 1977); *In re Tomlinson*, 363 F.2d 928, 150 U.S.P.Q. 623

(C.C.P.A. 1966).” *In re Geiger*, 815 F.2d 686, 688; 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987).

There is no assurance, no reasonable expectation of success, based on the slim teaching of GB 2131067 that polyethylene would function to properly inhibit bore-hole wall invasion. The Federal Circuit has held that, in order for an invention to be obvious over the prior art, two things must be found in the prior art, and not in the Appellants’ disclosure — (1) the suggestion of the invention, and (2) the expectation of its success. *In re Vaack*, 947 F.2d 488, 493; 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). Applicants respectfully submit that both of these elements are absent in the instant application. There is no evidence on the record that polyethylene performs as ethylene/propylene copolymer in the method of GB 2131067.

It is thus respectfully submitted that a prima facie 35 U.S.C. §103 rejection has not been made. The instant rejection is thus overcome and should be withdrawn. Reconsideration is respectfully requested.

It is respectfully submitted that the arguments, amendments and terminal disclaimer presented above overcome the rejections and place the claims in condition for allowance. Reconsideration and allowance of the claims are respectfully requested. The Examiner is respectfully reminded of his continuing duty to indicate allowable subject matter. The Examiner is also invited to call the Applicants’ attorney at the number below for any reason, especially any reason that may help advance the prosecution.

Respectfully submitted,
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